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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
(SAN FRANCISCO DIVISION)

FINJAN LLC,

Plaintiff,

v.

PALO ALTO NETWORKS, INC.,

Defendant.

Case No. 3:14-cv-04908-JD

**PARTIES' JOINT STIPULATION OF
DISMISSAL OF U.S. PATENT NOS.
6,804,780; 7,613,926; AND 8,677,494**

Hon. James Donato
Ctmm: 11, 19th Floor

Pursuant to Federal Rule of Civil Procedure 41(a), Plaintiff Finjan LLC (“Finjan”) and Defendant Palo Alto Networks, Inc. (“PAN”) hereby agree and stipulate:

In Finjan’s case against ESET, LLC and ESET SPOL. S.R.O., pending in the United States District Court for the Southern District of California, Judge Bencivengo found that the asserted claims of U.S. Patent No. 6,804,780 (the “’780 Patent”) and four other Finjan patents are invalid on the grounds that the claim term “Downloadable,” as used in those claims and construed by that court, is indefinite. *Finjan, Inc. v. ESET, LLC*, No. 3:17-cv-0183-CAB-BGS (“*ESET*”), Dkt No. 869 (S. D. Cal. Mar. 29, 2021). Based on that order, Judge Bencivengo entered judgment of invalidity with regard to those patents. *Id.* at Dkt. No. 875 (May 20, 2021). Finjan appealed that judgment to the United States Court of Appeals for the Federal Circuit. *Id.* at Dkt. No. 878 (June 17, 2021). On November 1, 2022, the Federal Circuit reversed the district court’s claim construction, vacated its grant of summary judgment, and remanded for further proceedings. *Finjan LLC v. ESET, LLC*, 51 F.4th 1377 (Fed. Cir. 2022). The Federal Circuit mandate issued on January 3, 2023.

Finjan has asserted the ’780 Patent in this case against PAN. Finjan has also asserted two other patents that—although not asserted in *ESET* and therefore not included in Judge Bencivengo’s order and judgment—also use the claim term “Downloadable,” namely U.S. Patent No. 7,613,926 (the “’926 Patent”) and U.S. Patent No. 8,677,494 (the “’494 Patent”).

The parties previously agreed to dismissal of Finjan’s claim of infringement of the ’780 Patent (Counts I and II of Dkt. No. 112), the ’926 Patent (Counts V and VI), and the ’494 Patent (Counts XIII and XIV) without prejudice to Finjan’s reassertion of these three patents against PAN by filing a new infringement action if and only if the judgment of invalidity of the ’780 Patent were to be reversed or vacated on appeal. (Dkt. No. 156.) This Court ordered, “The court will enter dismissal of Counts I, II, V, VI, XIII, XV, and XVII of Dkt. No. 112 and related counterclaims only when dismissal is not conditional on subsequent appeals.” (Dkt. No. 157.)

On January 17, 2023, Finjan filed a motion to sever and stay its infringement claims for the ’780, ’926, and ’494 Patents for adjudication following resolution of the remaining patents-in-suit. (Dkt. No. 219.) On May 15, 2023, the Court denied Finjan’s motion to sever and stay the ’780, ’926, and ’494 Patents and invited the parties to submit a proposal for litigating the claims, which

1 “may include dismissal of the relevant claims without prejudice to Finjan filing a new infringement
2 action, consistent with the parties’ previous agreement at Dkt. No. 156.” (Dkt. No. 248.)

3 The parties now have agreed to stipulate to the dismissal of Finjan’s claims of infringement
4 of the ’780 Patent (Counts I and II of Dkt. No. 112), the ’926 Patent (Counts V and VI), and the
5 ’494 Patent (Counts XIII and XIV) without prejudice to Finjan’s reassertion of these three patents
6 against PAN by filing a new infringement action if and when Finjan chooses to do so. The parties
7 also have agreed to stipulate to the dismissal of PAN’s counterclaims for the ’780, ’926, and ’494
8 Patents without prejudice (Counts I, II, V, VI, XIII, XIV, XV, and XVII of Dkt. No. 116).

9 Finjan and PAN entered into a separate Patent Assertion Agreement in August 2021 that
10 includes a tolling provision relating to damages for the ’780, ’926 and ’494 Patents following
11 reversal of the judgment of invalidity of the ’780 Patent.

12 Each party shall bear its own costs and fees pertaining to the dismissed patents.

13 **IT IS SO STIPULATED, THROUGH COUNSEL OF RECORD**

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15 Dated: May 30, 2023

Respectfully Submitted,

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PALO ALTO NETWORKS, INC.

ATTESTATION PURSUANT TO CIVIL L.R. 5-1(i)

In accordance with Civil Local Rule 5-1(i)(3), I attest that concurrence in the filing of this document has been obtained from any other signatory to this document.

/s/ Juanita R. Brooks
Juanita R. Brooks

[PROPOSED] ORDER

PURSUANT TO STIPULATION, the Court hereby orders the following:

Finjan's claims for infringement of U.S. Patent No. 6,804,780 (Counts I and II of Dkt. No. 112) are dismissed without prejudice;

PAN's counterclaims and defenses with regard to U.S. Patent No. 6,804,780 (Counts I and II of Dkt. No. 116) are dismissed without prejudice;

Finjan's claims for infringement of U.S. Patent No. 7,613,926 (Counts V and VI of Dkt. No. 112) are dismissed without prejudice;

PAN's counterclaims and defenses with regard to U.S. Patent No. 7,613,926 are dismissed without prejudice (Counts V and VI of Dkt. No. 116).

Finjan's claims for infringement of U.S. Patent No. 8,677,494 (Counts XIII and XIV of Dkt. No. 112) are dismissed without prejudice;

PAN's counterclaims and defenses with regard to 8,677,494 (Counts XIII, XIV, XV, and XVII of Dkt. No. 116) are dismissed without prejudice.

IT IS SO ORDERED.

Dated:

Hon. James Donato
United States District Court Judge